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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,078	07/05/2005	Harald Weigelt	STERN22.001APC	6848
20995 7590 07/23/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER LEE, LAURA MICHELLE				
ART UNIT		PAPER NUMBER		
3724				
NOTIFICATION DATE		DELIVERY MODE		
07/23/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

### Office Action Summary

**Application No.**

10/522,078

**Applicant(s)**

WEIGELT, HARALD

**Examiner**

LAURA M. LEE

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 6, 10 and 13 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5, 7-9, 11 and 12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 1/19/2005: 4/04/2008  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 6, 10, 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/04/2008.
2. Applicant's election without traverse of Group I, claims 1-5, 7-9, 11-12 and 14-15 in the reply filed on 4/04/2008 is acknowledged.

### ***Specification***

3. On page 5, line 37, there is a reference to the claims. This reference to the claims should be removed. If upon allowance of the application, the claims may become renumbered and therefore would not be consistent with the specification. Also, it's possible that during prosecution the scope of the claims could change.
4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

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As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. **Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.** If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

6. Claim 1, 2, are objected to because of the following informalities:

Claim 1 is missing a transitional phrase (i.e. comprising) between the preamble and body of the claim. It is also suggested to reword the last four lines of claim 1 to make them easier to follow.

Claim 2, recites "wherein the device for securing against rotation comprises a stripping element with an irregular cross-sectional shape." However, as the stripping

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element is already mentioned in claim 1, the claim should be changed as follows or similar -- wherein the device comprises an irregular cross section.-- However, the limitation "irregular" is indefinite as mentioned below, under 35 USC 112.

Claim 3 should read "wherein the hole comprises an elongated or polygonal hole.

Claim 4, should be changed to "The stripping device as in claim 1, wherein the hole has three straight sides and one curved side.

Claim 5, lines 3 and 5, "the latter" should be changed to --the stripping element--.

As is, Claim 7, should be changed from "wherein at least one guide surface is provided between stripping element and guide element, the length of which surface can be selected" to -- further comprising at least one guide surface between the stripping element and the guide element, the length of said guide surface can be . Also, the claim needs to be changed to positively state the guide surface is on the guide element.

Claim 11, should be changed to --the fastening piece, or the guide element and the fastening piece.--

Claim 12, should be changed from "arranged between stripping element or guide element and cutting tool" to -- arranged between the stripping element or guide element and the cutting tool--.

Claim 14, line 2, the limitation "can be provided" should be removed.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

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7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 5 is claiming two embodiments in the same claim. Only a singular embodiment can be claimed in each claim.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 2, 5, 7, 9 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 6-8, recites "wherein a device... is provided." The recitation of a device is not understood in combination with the preamble "a stripping device." Is the device a separate device and as such the preamble should be changed? Or is the device part of the stripping element, in which case the stripping element is incorrectly being claimed twice? It is postulated that the applicant intends that the device is part of the stripping element and therefore it is suggested to change the limitation from "wherein a device configured to essentially prevent the stripping device from rotating" to -- wherein the stripping element has a device configured to essentially prevent the stripping device from rotating--, or similar language.

Claim 2, recites that the stripping element has an irregular cross-sectional shape. It is not understood what is meant by irregular. Does that mean not circular or not symmetrical, or something else?

Claim 5 is claiming two guide elements, however, a guide element is already presented in claim 1. It is not understood if these are the same elements.

Regarding claims 7, 9 and 14, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-5, 7-9, are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (U.S. Patent 5,056,392), herein referred to as Johnson. Johnson discloses a stripping device (see Figures) for use with a cutting tool (punch, 46) for machining a workpiece, at least one fastening piece (eccentric, 24) for fastening it to the cutting tool, a spring elastic element (spring, 52) arranged outside the workpiece contact region, a stripping element (stripper, 74), which comes into contact with the workpiece and surrounds the cutting element (46), and at least one guide element (48) guiding the stripping element is provided, wherein a device (74c/d) configured to essentially prevent

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the stripping element from rotating is provided, the device for securing against rotation having a pairing, formed asymmetrically at least in one direction of stripping element and a hole (slots 110) or an opening in the guide element in which to fit the stripping element so as to ensure that the stripping element will be installed with a unique orientation.

In regards to claim 2, Johnson discloses wherein the stripping element (74) has an irregular cross-section shape (see Fig. 3).

In regards to claim 3, Johnson discloses wherein the hole (slots, 110) is elongated.

In regards to claim 4, Johnson discloses where the hole (110) has three straight sides (between holes 110) and one curved side (110).

In regards to claim 5, Johnson discloses wherein the guide element has a guide sleeve (48) at least partially surrounding the stripping element (74) in a guiding manner and/or at least one guide bushing is arranged as a guide element within the stripping element.

In regards to claim 7, Johnson discloses a guide surface (48) with a length.

In regards to claim 8, Johnson discloses wherein the stripping element (74) has an essentially straight section (74b) and a protruding section (circumference) and guide surfaces (74d) being provided on the straight and the protruding surfaces of the stripping element.

In regards to claim 9, Johnson discloses wherein the stripping element (74) has at least one guide surface facing the cutting element (46).



In regards to claim 11, Johnson discloses wherein the guide element (48) is formed integrally with the fastening piece (24).

In regards to claim 12, Johnson discloses wherein the elastic spring element (52) is arranged between the guide element (48) and the cutting tool (46).

In regards to claim 14, Johnson discloses wherein the stripping element (46) has a shape (square) and a material (high speed steel).

In regards to claim 15, Johnson discloses wherein the spring is made of a springy material.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA M. LEE whose telephone number is (571)272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura M Lee/

Examiner, Art Unit 3724

7/17/2008

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724